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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,577	01/16/2002	Horst Rathert	70418	8660

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EXAMINER

PETERSON, KENNETH E

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/051,577

Applicant(s)

RATHERT, HORST

Examiner

Kenneth E Peterson

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 4-7, 9-13 and 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8 and 14 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. Applicant's election with traverse of group I in Paper No. 7 is acknowledged. The traversal is based upon a misunderstanding of what is meant by "disclosed combination" in MPEP 806.05(d). Applicant perceived "disclosed combination" to be one of the claims. However, the claims would be the "claimed subcombination", not the "disclosed combination". What MPEP 806.05(d) means by "the disclosed combination" is the invention in its entirety as set forth in the specification and drawings. In this case, for example, the *claimed* subcombination of group III having telescoping adaptors *could* be used without the two retractable and extendable conveyors of the *disclosed* combination. A second example is that the *claimed* subcombination of group II having an oblique elastic clamp could be used with a single disposal chute, as opposed to the separate disposal chutes of the *disclosed* combination. A third example is that the *claimed* subcombination of group V having a block with elastic filled recesses could be used with non-changeable knives, as opposed to the knives that are displaceable for changing as set forth in the *disclosed* combination.

Nonetheless, after examining group I, Examiner found that he had additional time left and proceeded to examine group II as well. The claims of group II (3,14) were found to be allowable. If Applicant was to combine claim 3 or claim 14 into the linking claim 1, and all of the 112 problems are fixed, the case could be allowed and all of the other groups could be rejoined, since there would be no burden to do so at that point.

New claims 15-18 are drawn to group III and therefor stand non-elected.

Claims 4-7,9-13,15-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

2. The drawings are objected to because the number 3~ appears in the drawings but not in the disclosure. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. Claims 1,2,8 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is not understood how the telescoping adaptors work. How are they "shutter like", or how are they "accordion like". It is not at all clear how one would make or use them, since the specification and drawings lack sufficient detail.

It is not understood how the conveyor moves to & fro, nor how or why the conveyor moves up and down. It is not at all clear how one would make or use the conveyor, since the specification and drawings lack sufficient detail.

The specification recites that the cutting units are "designed as elements that are closed in themselves". This is not understood.

4. Claims 2 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim has the phrase "the cutting units have a flow of forces that is closed in itself". It is not clear what weight should be given to this phrase.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarring '336, who shows a three-knife book trimmer with all of the recited limitations including an obliquely swinging first knife (974) having a block front pressing element (766), and obliquely swinging second knives (1491) having a block head front pressing element or a block foot pressing element (1432). Sarring also shows a conveyor (1294) that spans both cutting stations. As much as can be understood, the cutting stations have a flow of forces that is closed in itself.

7. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

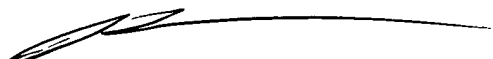
8. Claim 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Made of record but not relied on are patents to Zechini, Bryson, Kile and Zurlo showing book trimmers with clamps. Patents to Valiquette and Seybold are notable for their elastic clamps. Campbell shows an elastic clamp having an oblique surface.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Peterson whose telephone number is 703-308-2186. The examiner can normally be reached on Monday-Thursday, 7:30-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached at 703-308-1082.

All responses are encouraged to be by fax at 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

kp  
3-Sep-03



KENNETH E. PETERSON  
PRIMARY EXAMINER